



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/831,216 | 05/04/2001 | Jan Nevermann | H&U104 | 1455 |

7590

01/28/2004

Marlana Titus
Nash & Titus
6005 RIGGS ROAD
LAYTONSVILLE, MD 20882

| |
|----------|
| EXAMINER |
|----------|

HUI, SAN MING R

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1617

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/831,216

Applicant(s)

NEVERMANN ET AL.

Examiner

San-ming Hui

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

DETAILED ACTION

Applicant's response filed October 20, 2003 have been entered.

Claims 11-22 are herein examined on the merits.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admissions regarding the prior art in the specification in view of Moberg (WO 96/11572).

On page 4 of the specification, applicants disclose that two German patents (DE OS 3227126 and 3229097) teach that certain combinations of anionic surfactants, aliphatic and aromatic carboxylic acids as well as a few heteroatomic acids are capable of killing off viruses, bacteria and fungi.

Applicant's admissions regarding the prior art on page 4 of the specification, do not teach the employment of triglycols in its combination composition capable of killing off viruses, bacteria and fungi. Applicant's admissions also do not teach specific aromatic or aliphatic carboxylic acids to be employed in its combination composition. Further, applicant's admissions do not teach a method of combatting microorganisms employing its combination composition.

Moberg teaches an antimicrobial/disinfectant composition comprising carboxylic acids such as propionic acid, hydroxypropionic acid, see particularly claim 4. Moberg further teaches the employment of propylene glycol and butylene glycol in its composition, see particularly claim 3. Moberg further teaches a method of combating microorganisms employing carboxylic acids and diols, see particularly claim 12.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a diol (e.g. propylene glycol) in the combination composition restated by the applicant on page 4 of the specification. It would have also been obvious to employ the claimed carboxylic acids and diols in a method of combating pathogenic organisms.

One of ordinary skill in the art would have been motivated to employ diol (e.g. propylene glycol) in the combination composition restated by the applicant on page 4 of the specification because diol are known to be useful in antimicrobial compositions. It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be useful for the very same purpose, *In re Kerkhoven*, 205 USPQ 1069, 1072 (CCPA 1980). Moreover, the employment of two agents known to be useful in a method of combating microorganisms would be reasonably expected to be useful in combating pathogenic microorganisms regardless of the host. The two agents, singly or in combination, would be expected to exhibit antipathogenic activities, regardless of its cause, absent evidence to the contrary. No such evidence is seen.

Response to Arguments

Applicant's arguments filed October 20, 2003 averring the cited prior art's failure to teach the herein claimed composition as effective in treating plant pathogens have been fully considered but they are not persuasive. Claims 11-21 are drawn to composition. There is no limitation, other than the functional limitations, recited in the claims to distinguish the herein claimed composition and that suggested by the cited prior art. Such functional limitation is considered as intended use. Examiner directs attention to the Dillon ruling where the court sitting *in banc* ruled that the recitation of new utility for an old and well-known composition does not render that composition new (See *In re Dillon* 16 USPQ 2d, 1897 at 1900 (CAFC 1990)). The mere mentioning of intended treatment or prophylaxis use as herein recited fails to provide a distinguishing claim limitation, unless that amount is different from the prior art and critical to the use of the claimed composition (See *In re Dillon* 16 USPQ2d 1897 at 1902). As to claim 22, the only claim drawn to a method, the prior art references meet all the claimed limitations because two agents known to be useful in a method of combating microorganisms would be reasonably expected to be useful in combating pathogenic microorganisms regardless of the host. Furthermore, Moberg actually teaches the composition can be applied to plants, e.g., fruits or flower bulbs, to prevent the growth of mould (see page 15, lines 1-2). Therefore, the claims are seen to be properly rejected under 35 USC 103.

Applicant's arguments filed October 20, 2003 with regard to the difference between the standard of inherency and that of obviousness have been considered, but

Art Unit: 1617


are not found persuasive. Examiner notes that the rejection set forth in the previous office action is not based on inherency. As discussed above, the herein claimed composition is not distinguished from that suggested by the cited prior art. In other words, the recited composition contains the same ingredients of the cited prior art. The functional limitations recited in the instant claims do not lend patentable weight to the instant composition claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to San-ming Hui whose telephone number is (703) 305-1002. The examiner can normally be reached on Mon 9:00 to 1:00, Tu - Fri from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, PhD., can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

San-ming Hui
Patent Examiner
Art Unit 1617


SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER

1/23/04